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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,314	07/30/2001	Kota Yoshikawa	010935	8261

23850 7590 11/26/2003

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EXAMINER

GARRETT, DAWN L

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/26/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO9

# Office Action Summary

Application No.

09/916,314

Applicant(s)

YOSHIKAWA, KOTA

Examiner

Dawn Garrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. This Office action is in response to the amendment dated September 23, 2003, paper no. 8.
2. Claims 1 and 3 are canceled. Claims 2 and 20 were amended. Claims 2 and 4-20 are pending. Claims 4-19 are withdrawn. Claims 2 and 20 are currently under consideration.
3. The objections to claims 2 and 20 set forth in paper no. 7 (mailed June 23, 2003), par. 5 and 6 are withdrawn due to the amendment and applicant's explanation in the response.
4. The rejection of claim 3 under 35 USC 102(e) as being anticipated by Arai et al. (US 2001/0041268) set forth in paper no. 7, par. 8 is withdrawn due to the cancellation of claim 3.
5. The rejection of claim 3 under 35 USC 103(a) as being unpatentable over Tamano et al. (US 5,811,834) set forth in paper no. 7, par. 10 is withdrawn due to the cancellation of claim 3.
6. The rejection of claim 2 under 35 USC 103(a) as being unpatentable over Tamano et al. (US 5,811,834) set forth in paper no. 7, par. 10 is maintained.
7. The rejection of claim 20 under 35 USC 103(a) as being unpatentable over Tamano et al. (US 5,811,834) in view of Arai et al. (US 2001/0041268) set forth in paper no. 7, par. 11 is maintained.

**Response to Arguments**

8. Applicant's arguments filed September 23, 2003 have been fully considered but they are not persuasive. With regard to the rejection of claim 2 over Tamano et al., applicant argues "Applicants note that there is no suggestion of a problem of oxidization of the cathode in Tamano et al., and therefore no suggestion or motivation to provide a film to prevent oxidation." Applicant does acknowledge, however, that Tamano et al. teaches in col. 24, lines 47-48 that the cathode may be formed of two layers. The examiner notes the Tamano cathode may be formed of two layers or more and include materials such as magnesium and calcium (which are alkaline earth metal materials per the first conductive film) as well as titanium and ruthenium per the instant second conductive film. The examiner submits the layers disclosed by Tamano et al. read upon the layers applicant is claiming, because they are comprised of the same materials and intended use is not patentably significant. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430. Furthermore, in response to applicant's argument that a film for preventing oxidation is not taught by Tamano et al., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. With regard to the rejection of claim 20 over Tamano et al. in view of Arai et al., the examiner respectfully maintains the rejection wherein the two layer cathode of Tamano is relied upon and Arai teaches a further protective TiN layer. Applicant argues "Arai et al. does not have the two-layer structure recited in claim 20". The examiner submits the Ru, Rh, Ir, Os, Re and oxides thereof layer is taught in the Tamano et al. reference. Applicant again argues Tamano does not suggest solving the problem of oxidation. Again, the examiner submits the layers disclosed by Tamano et al. in view of Arai et al. read upon the layers applicant is claiming, because they are comprised of the same materials and intended use is not patentably significant. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of

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making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (703) 305-0788. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached at (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

*D.G.*

D.G.

November 24, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

*Cynthia H. Kelly*